

REMARKS

This Amendment is submitted in response to the Office Action mailed on December 17, 2007. Claims 1, 2 and 16 have been amended, and claims 22-25 stand withdrawn pursuant to a restriction requirement raised by Examiner. Claims 1-21 remain pending in the present application. In view of the foregoing amendments, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and request reconsideration of the application in this regard.

Claim 1 has been amended as suggested by Examiner to overcome the objection to that claim. Accordingly, Applicants respectfully request that the objection of claim 1 be withdrawn.

The Examiner has objected to the Declaration as allegedly being defective. In particular, the Examiner takes the position that the Declaration does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be “material to patentability as defined in 37 CFR 1.56”. Examiner’s objection is not understood.

In particular, Examiner’s attention is drawn to Applicants’ Declaration mailed on December 1, 2003 that recites:

§ 1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine: ...

In view of the above, Applicants respectfully request that the Examiner's objection to the Declaration be withdrawn.

Claim 1 stands rejected under 35 U.S.C. §102(b) as being anticipated by Jacobson, U.S. Patent No. 4,545,374. Claims 2-13 and 16-21 stand rejected under 35

U.S.C. §103(a) as being unpatentable over Jacobson in view of Simonson, U.S. Publication No. 2003/0083688. Lastly, claims 14-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jacobson, Simonson and Koros et al., U.S. Patent No. 5,928,139. While Applicants respectfully traverse these rejections, Applicants have amended each of independent claims 1, 2 and 16 to more sharply define the claimed invention over the prior art of record and respectfully request that the rejections be withdrawn.

In particular, Applicants have amended independent claim 1 to recite that the placement wire is received within at least a portion of the blade member. Independent claim 2 has been amended to recite that the first and second wires are received within at least a portion of the dissector member. Lastly, independent claim 16 has been amended to recite that the first wire is received within at least a portion of the blade member. Support for these amendments is located at Page 6, line 27 through Page 7, line 4 and Page 10, lines 8-18, for example, and in the figures. By way of example, in one embodiment the blade member includes first and second apertures (34, 36) that are sized and configured to receive the corresponding first and second placement wires (14, 16) as shown in Fig. 2.

Applicants respectfully submit that the rongeur forceps (18) of Jacobson does not receive any placement wire within at least a portion thereof as now recited in each of amended independent claims 1, 2 and 16. In view of the amendments to each

of independent claims 1, 2 and 16 as discussed above, Applicants submit that Examiner's interpretation of Jacobson as set forth in the first full paragraph on Page 3 of the Office Action is not applicable. Consequently, for at least this reason, Applicants respectfully submit that each of independent claims 1, 2 and 16 patentably defines over Jacobson taken alone, or in combination with the other prior art of record, and the rejections should be withdrawn.

Moreover, as each of dependent claims 3-15 and 17-21 depend from allowable independent claims 2 and 16, respectively, and further as each of these claims recites a combination of elements not taught or suggested by the prior art of record, Applicants submit that these claims are allowable as well.

Conclusion

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this affect is earnestly solicited. If there is any issue that remains which may be resolved by telephone conference, the Examiner is invited to contact the undersigned in order to resolve the same and expedite the allowance of this application.

Applicants do not believe that this response requires that any fees be submitted, however, if any fees are deemed necessary, these may be charged to Deposit Account No. 23-3000.

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Respectfully submitted,

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